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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,436	03/31/2004	Kevin Conwell	13603	5446

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ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/814,436	Applicant(s) CONWELL ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1771

1. The Examiner notes the presence of several informalities in the specification which should be corrected. Note that at page 4, line 7 "4" is believed should be –14— and on page 5, line 16 "14" refers to an adhesive, not a mesh label face. In addition other informalities may be present and applicants are urged to correct them.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 13 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 10 it appears proper to delete "has been one of" and insert therefore –either--. Claims 13 and 17 should use proper Markush language in place of "comprising" and in line 3 of each claim the phrase "a blend of polymers or copolymers and combinations thereof" reads upon many non contemplated embodiments. Finally, claims 18 and 19 are exact duplicates thereof.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by either Schneberger et al or Harder et al. Note particularly Schneberger et al, the Abstract, Col 2, lines 52- Col 3, line 15, Col 6, lines 39-48, particularly line 46; Harder et al, Col 2 , lines 20-26, Col 3, lines 14-15, Col 4, lines 6-16, particularly line 16. Each of the

Art Unit: 1771

references clearly discloses articles such as labels which can comprise a woven backing coated by a suitable adhesive, which is all applicants' independent claim requires.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admissions in the specification at page 1, lines 13-15 taken in view of either Schneberger et al or Harder et al. Applicants admit in their specification that RFID labels are known in the art, but apparently the resulting properties stemming from the use of hard polymeric films are not desirable. However, each of the "secondary" references are again relied upon as set forth above, disclosing the use of woven backings as particularly suitable for use in label articles, and accordingly one of ordinary skill would have ample motivation to incorporate such woven backings into the RFID containing tire label structures admitted by applicants as known and thereby either form, or clearly render obvious, the claimed genus of label structures. With respect to the dependent claims such parameters as the particular fibers utilized for the backing, filament diameters, thread counts, layer thicknesses, presence of primer adhesive layers, cap layers and particular adhesive composition are each believed to be, if not

Art Unit: 1771

expressly or inherently disclosed in the relied upon combinations, obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the PGPub of the inventors, US 2005/0221704 A1 and an earlier effort thereof, US 2004/0095244 A1, Nakagawa et al and US 2003/0211273, also having inventor Conway as a coinventor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/814,436

Page 5

Art Unit: 1771

Daniel Zirker
Primary Examiner
Art Unit 1771

Daniel Zirker